

Remarks

This amendment and the accompanying remarks respond to the Examiner's letter mailed September 18, 2002. Reconsideration of this application is respectfully requested.

Claims 1 - 18 have been canceled.

Claim 19 has been rejected as anticipated by Ikeda. The office action states:

Ikeda discloses a plant (seaweed) container comprising a receptacle 5 having a top opening 6, a closed bottom 3, and a top flap 7 of sufficient size to cover the seaweed placed in the receptacle, the receptacle and flap consisting essentially of a front panel 1 and a back panel 1 (cl. 5, line 55), at least one of the front and back panels being triangular, the front and back panels being connected to each other along two edges 21' of the triangle (col 5, line 56). ... For claim 19 Ikeda further discloses both panels 1,1 have a triangular shape. ***Note, the examiner is not considering flap 7 to be part of the back panel because flap 7 is a separate element which, when the flap is folded over the opening 6, the line of separation will be evident.*** (Emphasis added.)

The rejection cannot stand because Ikeda does not show every element of claim 19. Claim 19 defines

A plant container comprising a receptacle having a top opening, a closed bottom, and a top flap of sufficient size to cover a plant placed in the receptacle, the receptacle and flap consisting essentially of a front panel and a back panel, each of the front and back panels being triangular in shape, the front and back panels being connected to each other along two edges of the triangle.

The office action clearly states that the flap 7 if Ikeda is not considered to be part of the of the back panel. However the claim requires that the flap **and** receptacle *merely means comprising* consist essentially of a front panel and a back panel, each of the front and back panels being triangular in shape The emphasized phrase "consisting essentially of" "limits the scope of the claim to the specified materials "and those that do not materially affect the basic and novel characteristics of the claimed invention. MPEP § 2111.03" (emphasis in original). Since the flap 7 is considered a separate element, the Ikeda package cannot **consist essentially of** a front panel and a back panel each of which is triangular. Instead, Ikeda's package includes one panel that is pentagonal, with the flap being formed from the more or less rectangular portion of the back panel that extends above the top edge of the front panel. As applied in the office action, Ikeda does not have a receptacle and a flap which together consist essentially of two triangular panels. Accordingly, the anticipation rejection based on Ikeda should be withdrawn.

Claim 19 has also been rejected as obvious over Straeter as modified by Ferguson. This combination cannot stand.

The office action concedes that neither Straeter nor Ferguson shows a plant container made from two separate triangular sheets. Instead it proposes that it would have been obvious to flatten the Straeter product shown in Figures 3 and 4 so as to produce a sleeve made from two triangular panels. The office action, paragraph 19, states: [B]oth panels of Straeter, when rolled up as shown in figs. 3-4 are shaped like or relating to a triangle.

STOP HERE The proposed modifications to Straeter do not produce triangular panels for two reasons. First, even the front panel of the flattened Straeter wrapper is not triangular, but rather has at least four edges. This is true because the side seams do not and cannot meet at the bottom of the sleeve. Second, the rear panel of the flattened Straeter wrapper must come to a point at the middle of the back in order to provide a

flap. This panel, therefore, must be a pentagon (if one includes the short bottom edge) or a quadrilateral (if one incorrectly assumes that the two side seams actually meet at the bottom.) Each of the reasons why Straeter cannot be made to form two triangular panels is discussed below.

in view of Ferguson
The flattened Straeter wrapper would have a squared off, open bottom and *definition* would not be triangular, as claimed. The wrapper shown in Straeter Figures 3 and 4 is made by wrapping the sheet shown in Figures 1 and 2 around a bouquet. Rolling Straeter's sheet (which has very nearly the proportions of a sheet of 8.5 x 11 paper) around a bouquet, making sure to leave room for the stems to stick out as shown by Straeter, and thereafter flattening it as suggested in the office action produces a flat panel that has four sides because it must have an open bottom.¹ To say that a trapezoid is "related to" a triangle because it has a top, two sides that taper toward each other plus a fourth side that is short but necessary to Straeter's method is simply not fair usage of the English language. Why then isn't the Ferguson's package "triangular"? Is it because his bottom is longer than Straeter's? No definition in any dictionary proposes to define how short a side of a trapezoid must be to call the figure a triangle because a four-sided figure has a different name and is not "triangular".

*was not
relied on for
teaching*

The flattened Straeter wrapper **must** also have at least one panel that has one more edge than the other in order to provide the flap to fold over at the top. Straeter's front panel, if flattened, generally forms a trapezoid and his rear panel would be

1. In fact it appears impossible to create the wrapper of Figure 3 as Straeter shows. Straeter's edge 38 in Figure 3 appears straight and perpendicular to the axis of the wrapper. A single, rectangular sheet of paper cannot be rolled to obtain such a result while still keeping the corner 26 symmetrical about the axis and proportioned so it can fold over. Such a sheet inevitably has a front edge formed in part from edge 14 and in part from edge 16, and they are not co-linear. In other words, the top edge 38 of Straeter, contrary to what is shown, has a bend in it. So even if the front panel of the flattened Straeter comes to a point (which it does not), the panel would still have a quadrilateral shape, not triangular as claimed.

pentagonal. Accordingly, even if one were to say that one portion of the flattened Straeter wrapper is triangular, ^{Ferguson's teaching} the device would not have a front panel and a back panel, **each** of the front and back panels being triangular in shape as called for in claim 19. Claim 19 calls for the container to include a receptacle and a flap which consist essentially of two triangular panels joined along two edges. Straeter requires one of his panels to have one additional side in order to form the flap that extends above the top edge of the other panel. Without that extra side, Straeter cannot form a flap.

Since neither Ferguson nor Straeter modified as suggested has a triangular panel, much less two such panels, there is no way to combine them to obtain the claimed invention. Further, even if the cited references showed the elements of the applicant's invention (which they do not) there has been no showing that one of ordinary skill in the art would be motivated to combine them. It is now well settled that before references can be combined, there must be a demonstrated motivation to combine references. The motivation can be found in the references themselves, the nature of the problem confronted by the inventor, or the knowledge of those skilled in the art. See MPEP §§706.02j and 2143.01. The Federal Circuit has expressed the requirement this way:

[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.2d 1350, 1357 (Fed. Cir. 1998). The finding of a motivation to combine must be based on "actual evidence" and "must be clear and particular", not broad and vague. *In re Dembiczak*, 175 F. 3d 994, 999 (Fed. Cir. 1999). In *Dembiczak* the Board of Appeals was reversed when it and the examiner did not "particularly identify [a] suggestion, teaching, or motivation to combine the [prior art] references with the [known basic structure]" and failed to "make specific – or even inferential– findings

concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve as a proper obviousness analysis." *Id.* at 1000.

In this case the office action does not set out any motivation to combine the references, instead it merely concludes that it would be obvious to do so without any supporting fact other than the assertion of obviousness. The office action apparently argues that one would be motivated to seal the bottom of Straeter in order to protect the plants from injury. But one of ordinary skill in the art would not be motivated to do this. Straeter specifically says:

The floral grouping 28 is positioned on the upper surface 20 of the sheet of material 0 with the stem end 30 extending a distance beyond the second side 18 of the sheet of material 10

Column 3, lines 28 - 31. Straeter addresses that issue of protecting the stem end of a bouquet by providing various flaps on the bottom of his package. For example, in connection with Straeter Figure 9 discloses a

bottom flap 56 to the sheet material 10c. In this position the bottom flap 56 extends over the open lower end 40c of the wrapper 36c to substantially prevent movement of the floral grouping 28 in a direction 62 (Fig.9) out from the open lower end 40c of the wrapper 36c thereby substantially preventing the floral grouping 28 from shifting in the wrapper 36c and extending out from the open lower end 40c of the wrapper 36c.

Column 5 lines 57- 67. In connection with other embodiments, Straeter suggests a completely separate strap with adhesive on each end as shown in Figure 10. Straeter has already solved the problem of protecting the stem ends of bouquets from injury, and one of ordinary skill in the art would not be motivated to eliminate one feature of Straeter

for an entirely different solution to the same problem, especially when such a shift would require a completely different manufacturing technique using different machinery, and, as discussed below, entirely different operating principles.

The office action does not explain what would motivate a skilled artisan, who has rolled the Straeter sheet to form a conical shape and then flattened it, thereafter to seal the edges in some other manner than as provided for by Straeter. The proposed modifications to Straeter impermissibly alter the principles of operation of Straeter, both how Straeter's sheet is made and how Straeter's sheet is used. Straeter's product is made by cutting sheets of material to the selected shape and applying adhesive in selected locations. No heat sealing is involved in making the Straeter invention. In contrast Ferguson is making sleeves on what is called in the art a "sleeve machine". This machine feeds multiple layers of web under hot dies. The dies come down on the web material to cut adjacent sleeves from each other and to join the layers to each other. Ferguson acknowledges that such machines are well known in the art. See Ferguson, column 1, line 55 - column 2, line 3. These manufacturing techniques are entirely different.

Straeter's sheet is used by placing a bouquet on it and wrapping the sheet around the bouquet. Straeter says his invention relates to "a method of **wrapping** a floral grouping and ... to a sheet of material for wrapping a floral grouping..." Column 1, lines 46 - 48. Straeter's sheet has adhesive applied to selected regions. Once the sheet is rolled, the adhesive holds the sheet, and consequently the sheet retains its frusto-conical shape. An artisan who has rolled a Straeter sheet would find that it already holds its shape, and he would have no reason to heat seal the edges to one another as taught by Ferguson. Certainly the office action does not explain why the skilled artisan would abandon Straeter's adhesive. In fact, the office action does not even mention Straeter's adhesive. There is no suggestion in either Straeter or Ferguson that heat sealing is

better than using an adhesive. Each is appropriate for its application in their respective references, but there is no motivation to use one over the other.

A proposed modification cannot change the principle of operation of a reference. MPEP 2143.01; *In re Ratti*, 270 F 2d 810 (CCPA 1959). The office action proposes to abandon the principle of operation of Straeter, namely, making a wrapper by rolling a single sheet around a bouquet with the stems projecting out of the wrapper, and using adhesive to hold it

of making a preformed layers on a sleeve combination suggested by would completely discard operation of Straeter.

The Board of Patent Interferences recently dealt situation. Its non

opinion in *Ex Parte Bushhouse*, Appeal No 1998-1964 (copy attached) illustrates how the changed-principle-of-operation rule is applied. In that case Bushhouse had claims drafted to cover the exhaust pipe clamp shown below.²

U.S. Patent

Nov. 9, 1999

5,979,947

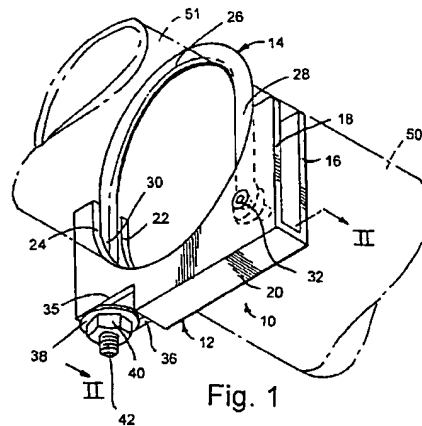


Fig. 1

together, in favor sleeve from two machine. The the office action the method of

Appeals and with a similar precedential

2. Claim 1 on appeal was:

A clamp assembly, comprising:

a yoke have a rigid body defining a concave, generally semicircular pipe-engaging edge for clamping against an associated pipe; a U-bolt having a generally semicircular pipe-engaging portion, an end of said U-bolt being pivotally attached to said yoke for rotation of said U-bolt about a pin having an axis substantially perpendicular to said body, said U-bolt being rotatable between a pipe-engaging position wherein said pipe-engaging edge of said yoke and said pipe-engaging portion of said U-bolt achieve substantially continuous circumferential engagement with the pipe and an open position wherein said clamp can be installed over the pipe, the other end of said U-bolt being threaded at its free end and receiving a nut thereon, said yoke including a bearing seat upon which said nut is tightened on said threaded end of said U-bolt to urge said pipe-engaging edge of said yoke

The examiner rejected the claims as obvious in view of Engman as modified by Powell.

Sept. 12, 1967

M. C. ENGMAN ET AL

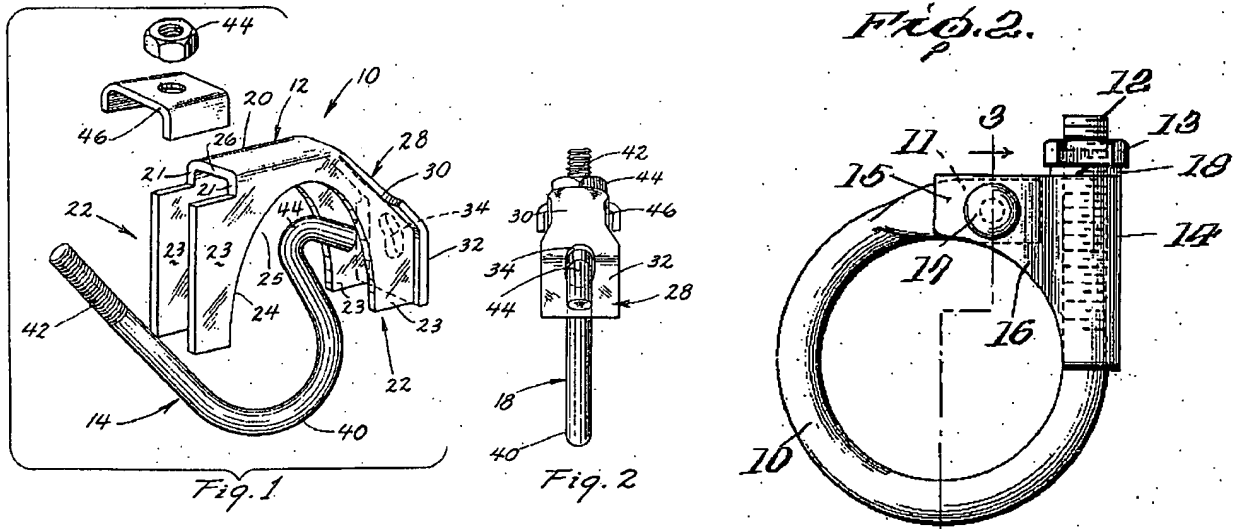
3,340,581 Sept. 14, 1937.

H. S. POWELL

2,093,210

CLAMP

Filed Sept. 13, 1965



The Examiner argued that it would have been obvious to provide Engman's clamp with the rivet 17 shown in Powell, also a muffler clamp, and therefore that the claimed invention was unpatentable.

On appeal the applicant argued, among other things, that "use of the Powell rivet to connect the clamp members 12 and 14 of Engman et al. would change the principle of operation of the clamp disclosed by Engman et al."

The Board specifically agreed with this argument, resulting in the allowance of Bushouse's patent. The same principle applies in this case. The proposed combination

and said pipe-engaging portion of said U-bolt together to apply radially compressive forces about the circumference of the pipe.

changes the principles of operation of Straeter in two ways. First, the proposed combination eliminates wrapping a single sheet around a bouquet leaving the stems protruding from the wrapper. Second, the proposed combination changes the way the wrapper is held together, eliminating Straeter's adhesive in favor of Ferguson's heat sealing. These changes totally eliminate Straeter's mode of operation and so the proposed combination is improper.

While making what was formerly one part in two pieces may be a reason to find some inventions obvious, that is not what the office action proposes. The office action proposes abandoning a critical part of Straeter (the adhesive) in favor of the sealed edges of Ferguson. There is no motivation suggested, much less supported by factual evidence, for one of ordinary skill in the art to make such a change.

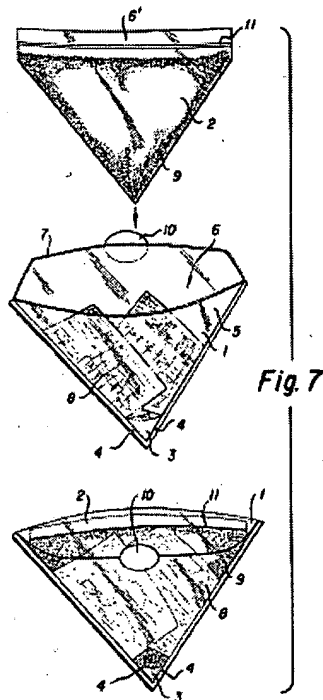
In summary, the office action ignored the fact that flattening Straeter's wrapper would produce a quadrilateral and a pentagon, and it improperly called both "triangular". Not only would the combination proposed by the office action not produce a triangular shape, but the resulting product would be useless for Straeter's purposes, namely, to wrap around a bouquet or other floral grouping. It is respectfully submitted that for the reasons stated above it would **not** have been obvious to combine the references in the manner proposed in the office action and even if the combination were made, the result would not be the claimed subject matter. Further, the proposed combination would completely eliminate the principles of operation of the Straeter patent. Accordingly the rejection of claim 19 for obviousness should be withdrawn.

Claim 20 should be allowed for the same reasons that claim 19 should be allowed, and in addition because not even the proposed combination would result in panels with the **same** triangular shape. Ignoring the open bottom that Straeter has and the fact that Straeter, as explained in footnote 1, cannot actually make a wrapper with a linear top edge for the front panel, his wrapper could not be made as proposed with both the front and back panels having the same triangular shape. As discussed above, Straeter must

have one pentagonal panel in order to create a flap. Accordingly, the rejection of claim 20 should be withdrawn.

The office action applies the Ikeda reference to claims 21, 22, 28, 29, 32, and 37

U.S. Patent Nov. 15, 1988 Sheet 5 of 10 4,784,864



- 40 under 35 U.S.C. 103. As noted above Ikeda requires flaps that make his panels generally pentagonal. Ikeda's flaps are required in order to fold over to hold the contents in. In applying Ikeda to claims 21 and 22, the office action takes the position that it would have been obvious to use isosceles or right triangles for the panels. However, Ikeda does not disclose a wrapper made from panels that are both triangles because he requires the flap 7. Ikeda could not serve his intended purpose without a flap to seal the top.

The triangular packages disclosed by Ikeda that do not have flaps are isosceles, and no modification of Ikeda is necessary. However, as noted above, the isosceles triangles of Ikeda do not produce the structure claimed by the applicant. Specifically, the isosceles packets disclosed in Ikeda do not show or suggest "a top flap of sufficient size to cover a plant placed in the receptacle, the receptacle and flap consisting essentially of" triangular front and back panels which are claimed. The only flap Ikeda suggests is one added to the top edge of at least one of the triangular panels, and the isosceles panels shown **cannot** make the flap as claimed because, the two seam edges being the same length, one cannot be folded over the other. The same applies to broadening Ikeda to have a ninety-degree angle between seams. Before Ikeda can suggest the claimed construction, it must suggest triangles

with side seams of different lengths. This arrangement is a precondition to achieving the claimed flap and container construction. But Ikeda teaches away from the claimed construction because his only flap makes his panel no longer a triangle. Therefore, one of ordinary skill in the art would not be motivated to modify the panels of Ikeda as suggested, and even if one did so, the result would not be the claimed invention. The rejection of claims 21 and 22 on this basis should be withdrawn.

Claim 23 has been rejected over the same combination of Straeter and Ferguson discussed in connection with claim 19. Claim 23 is patentable for the same reasons as 19. In addition none of the cited art shows two right triangular panels joined along the hypotenuse and one other edge to form a container as claimed, and there is certainly no suggestion in any of them to do so.

Claims 24 - 26 depend from 23 and should be allowable for the same reasons.

Claim 28 has been amended to depend from claim 19, and is allowable for the same reasons as claim 19.

Claim 27 has been allowed. It has been rewritten to correct the §112 issue, but it has not been rewritten in independent form because the applicant believes that the parent claims are all patentable.

Claims 28 and 29 have also been rejected as obvious over Ikeda and over the combination of Straeter and Ferguson discussed above. As discussed above, Ikeda does not and cannot teach or suggest a container with a flap made with two triangular panels that together form both the flap and the receptacle. Accordingly, the Ikeda package cannot be modified as suggested to achieve the claimed invention. The Straeter - Ferguson combination does not and cannot result in the claimed structure for the reasons discussed above. Therefore, the rejection of these claims should be withdrawn.

Claim 30 was rejected as anticipated by Ikeda and obvious in view of Straeter as modified by Ferguson. Claim 30 has been amended to depend from claim 19, and should be allowable for the same reasons that claim 19 is patentable. Claims 31 - 33 and 36 - 39 depend directly or indirectly from claim 30 and are patentable for the same reasons.

Claims 34 and 35 have been allowed. They have not been rewritten in independent form because the applicant believes that the parent claims are all patentable.

Claim 40 was rejected as obvious in view of Ikeda and obvious in view of Straeter as modified by Ferguson. Claim 40 has been amended to depend from claim 19, and should be allowable for the same reasons that claim 19 is patentable. Claims 41 - 46 depend directly or indirectly from claim 30 and are patentable for the same reasons.

Claims 47 - 53 have been canceled.

Claim 54 was rejected over Straeter as modified by Ferguson and the Italian patent to Nuova PNP (the Italian patent). Claim 54 describes

[a] plant container comprising a receptacle having a top opening for insertion of a plant therein and a top flap selectively folded over the top opening to cover the receptacle;
wherein the container is formed from two panels sealed together along substantially only two adjacent edges;
wherein each of the panels forms half of the receptacle and half of the top flap.

The rejection of claim 54 cannot be sustained because Straeter does not and cannot teach even one panel that could be joined with another panel along substantially only two adjacent edges to form a receptacle and a flap to close the receptacle, because there is no motivation to modify Straeter as suggested and then combine it with Ferguson, and because none of the references teach a plant container that has a

receptacle portion and a flap portion and is made out of two panels joined along substantially only two adjacent edges with each panel forming half of the receptacle and half of the flap. Further, as discussed below, the Italian patent adds nothing to the combination of Straeter and Ferguson.

As conceded in the office action (page 20) when wrapped the Straeter wrapping material does not form a complete cone. This is because the bottom of Straeter's wrapper is open so the stems can stick out. Therefore, the bottom edge of the hypothetically flattened Straeter wrapper is necessary to Straeter's purpose and makes Straeter's front panel necessarily a quadrilateral³. This bottom edge cannot be ignored because it is essential to how Straeter instructs his sheet should be used.

According to the office action, it would have been obvious to modify Straeter following the two-panel construction of Ferguson. However, such a modification would not yield the claimed construction since the bottom end portions of both Straeter and Ferguson are substantially straight and connect the two lateral seams. By contrast claim 54 is directed to a container formed from two panels that are sealed along "substantially **only** two adjacent edges". If the combination of Straeter and Ferguson is sealed along the only two **adjacent** edges, for example, one side and the bottom edge, the result does not produce a container because the remaining two edges are un-joined and so would not serve to contain a plant or bouquet. To make a container out of Straeter and Ferguson combined one could seal only two edges as called for in claim 54, but those edges would be the side seams and would not be **adjacent** to each other because of the intervening bottom edge. Thus even if it were obvious to combine Straeter and Ferguson, such a combination fails to meet the claimed subject matter.

3. Actually, the bottom of a hypothetically flattened Straeter is not a straight line for the same reason that the top edge is not a straight line.

The Italian patent is apparently cited for the proposition that the seams can be located to divide the container in half. This is a feature of any sleeve, including Ferguson's, that is made from two flat panels. The Italian patent does not disclose a flap of any kind for closing the top of the container. There is no plant container disclosed anywhere in the prior art that is made of two panels joined substantially only along two adjacent edges and each of which forms half of a receptacle and half of a flap for closing the top opening of the container. The Italian patent does not cure the deficiency of the Straeter-Ferguson combination.

As discussed above in connection with claim 19, there is no reason to combine teachings when to do so would destroy the operating principles of one of them. In Straeter the principle of operation is to take a single flat sheet that has adhesive selectively applied to it and roll the sheet around a bouquet with the stems outside the wrapper (as florists have done for many, many years) using the adhesive to hold the sheet in a wrapped condition around the bouquet. Various flaps, both integral to the sheet and separate but adhered to the sheet, are shown by Straeter to close the open ends of the wrapper. The proposed combination eliminates these flaps and the adhesive used to hold the wrapper together and instead uses an entirely different principle of use (and manufacture, as discussed above.)

Ferguson teaches away from folding over a top flap to protect the plant within. Ferguson discloses a plant sleeve with no flap and no need for a flap. The upper portion (that is, all of Ferguson's sleeve above the tear line 39) is intended to protect the foliage during shipment. It is well known that if potted plants are shipped together in a box, some method must be used to keep the foliage of one from commingling with foliage from its neighbors. If this is not done, removing plants from the box is likely to damage it and its neighbors. Ferguson's sleeve is directed to solving this problem. He says:

A packer places a potted plant into the container by opening the container at its large opening 33. The potted plant is then placed inside the container. The foliage generally does not project above the first and second panel transversely-extending long edges 29, 31. The upper portion of the sleeve can later be separated from the lower decorative portion by tearing the sleeve along tear line 39.

Column 4, lines 49 - 55. In the embodiment of Figures 1 -9 Ferguson shows a generally frusto-conical sleeve where the top edge when opened is generally circular and lies in a plane perpendicular to the vertical axis of the sleeve. Such an edge is well suited for protecting foliage. In Figures 10 - 13, Ferguson shows a sleeve that in use has an oval top that lies in a plane inclined with respect to a vertical axis through a pot placed in the sleeve. Ferguson does not suggest folding this higher part over to join the lower part of the oval. To the contrary, Ferguson specifically states that the higher part of his oval is to project upward to form a pick up point for the sleeve. Ferguson explains:

Alternatively, referring to FIGS. 10-13, the first angle 41a can be between 55° and 65°, and the second angle 45a can be between 85° and 90°. In a configuration having different angles, the first angle is preferably 60° and the second angle is preferably 90°. The two-angle configuration causes the container when filled to form a pickup point 201. The pickup point forms because a portion of the container, at the intersection of the container's first panel long edge 29 and its 60°-angulated side 25, projects further upwards than a portion of the container at the intersection of the container's first panel long edge 29 and 90°-angulated side 27. The pickup point makes it easier for a user to handle the filled container during packing (see FIGS. 10-13). It will be noted the perforations 39 are not present on these figures.

Column 4, line 62 - column 5, line 8. Thus when Ferguson forms an inclined top opening, he teaches to allow it to stick up rather than be folded over as a flap.

On the other hand, when Ferguson wants a sealing flap, he adds it to one of his trapezoidal panels. In manufacturing such a sleeve on a sleeve machine (see column 1,

line 55 - column 2, line 3 for a description of machines used industry-wide) this is done by offsetting the web that makes the front panel from the web that makes the rear panel.

Ferguson describes this as follows:

FIGS. 7 and 8 show an alternative embodiment in which the second panel transversely-extending long edge 31 is longitudinally spaced from the first panel transversely-extending long edge 29 so that the second panel transversely-extending long edge 31 protrudes beyond the first panel transversely-extending long edge 29. Having the second edge protruding beyond the first edge allows for a protruding portion 47 of the second panel 23 to be folded over the first panel 22 to provide a cover. The protruding portion of the second panel can have an adhesive strip (not shown).

Column 5, lines 9 - 20. Accordingly, when Ferguson wants a flap, he adds it to the top of the sleeve, extending from side seam to side seam and perpendicular to the vertical axis of the sleeve. When Ferguson forms his top opening on the bias, as in his Figures 10 - 13, Ferguson specifically states the advantage to be obtained by *not* folding it over. The office action does not explain why one of ordinary skill in the art would abandon the advantage of Ferguson's slanted top to form a closed top when Ferguson specifically teaches a different technique for closing his top.

As discussed above, it also is not evident why one would combine the Straeter and Ferguson references as proposed in the office action. Straeter teaches rolling a sheet with adhesive on it around a bouquet with the stems sticking out of the wrapped sheet so that the sheet forms a roughly frusto-conical shape, using the adhesive to hold the sheet rolled. Paragraph 13 of the office action does not even mention the presence of the adhesive on Straeter's sheet or supply any reason why one of ordinary skill in the art would abandon it. The office action does not explain why one of ordinary skill in the art, after forming the Straeter's open-bottomed "frusto-cone" and then flattening it, would discard those portions where there are more than two layers, especially since these

overlaps are where the adhesive is that holds it together. As discussed above the proposed combination improperly completely eliminates Straeter's principle of operation. Therefore, the rejection based on Straeter combined with Ferguson should be withdrawn.

Claims 55 -61 were rejected on the same basis as claim 54. All of the reasons that claim 54 is allowable apply equally to these dependent claims. The substance of the subject matter added by these claims has been discussed in connection with claims dependent on claim 19. Those discussions are equally applicable here, but will not be repeated.

The allowance of claim 62 is noted. That claim has not been rewritten at this time to include all the intervening subject matter because the applicant believes that the parent claims are patentable.

Claim 63 was rejected under section 112. This typographical error has been corrected.

Claim 63 was also rejected as obvious in view of the combination of Straeter and Ferguson and further in view of Nuova. Claim 63 describes

[a] container for a plant including two sheets of flexible material, the sheets being joined by seams along two pairs of corresponding edges and having a pair of corresponding free edges which are not connected to each other,

the container being convertible from an initial flattened condition in which the container is substantially closed to an open condition in which the free edges of the sheet bow away from each other to form an opening, the sheets, when in the open condition, being foldable along a line joining the two free edges and crossing one of the seams to form a flap that substantially covers the opening.

The absence of any motivation to combine Straeter and Ferguson has been thoroughly discussed and applies to the rejection of this claim. Those reasons need not be repeated. Even if one were to combine Straeter and Ferguson, the result would be

two panels, the front one being a trapezoid, and the back panel being a pentagon, with the top two edges of the pentagon forming the flap. There is no plausible reason why, having made the Ferguson-Straeter combination, one would then redesign the sleeve again by changing the location of the seams. There must be some **reason** that would motivate one to make the modification proposed, that the reason must be apparent from references cited. No reason at all is given in the office action. It is true that Italian patent shows a container with seams oriented as the office action describes, but no reason is given for why one would be motivated to make the combination. In the absence of a motivation to combine references and in light of good reasons not to (abandoning the adhesive and single sheet principles of Straeter), the combination of references is improper. It appears that the rejection of claim 63 was based entirely on hindsight. The rejection of claim 63 should be withdrawn.

Claims 64 - 69 have been rejected on the same basis as claim 63. These rejections are improper for the same reasons that the rejection of claim 63 is improper. The claims that depend directly or indirectly from claim 64 add subject matter that is the same as the subject matter of other dependent claims. The reasons why that added subject matter lends further patentability to the parent claim has been discussed above. Those reasons are equally applicable to claims 64 - 69, but will not be repeated here.

The specification was objected to because some reference numerals were misused. This has been corrected by correction the paragraphs where the errors occurred. In addition, one of the reference numerals 54 (of which there were two) in Figure 7a has been changed to 55. A corrected sheet of drawings with the new numeral highlighted is attached for the examiner's approval. In addition, the specification has been amended changing numeral such as "30" which had been used to refer collectively to 30a and 30b. The corrections to the specification and drawings do not add any new matter, and should resolve the problems with specification.

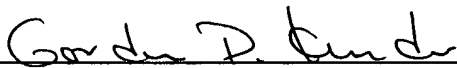
Conclusion

In view of the foregoing, the present application is believed to be in a condition for allowance and an early indication to that effect is earnestly solicited. If the application is not believed to be in condition for allowance, the Examiner is asked to telephone the undersigned to resolve any remaining issues.

Should a petition for an Extension of Time be necessary for the timely reply to the outstanding Office Action (or if such a petition has been made and an additional extension is necessary) petition is hereby made and the Commissioner is authorized to charge any fees (including additional claim fees) to Deposit Account No. 18-0988, under Attorney Docket No. AROOP9909USA .

Respectfully submitted,

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CERTIFICATE OF MAILING (37 CFR 1.8a)

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Gordon D. Kinder